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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,079	06/19/2000	James Hongxue Wang	11302-0600 (KC 13,404)	6296

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

8

DATE MAILED: 05/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant N .

09/599,079

Applicant(s)

WANG ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

- 1. The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2. Claims 1 and 3-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

A) The recited "graft copolymer of poly(ethylene oxide)" per claims 1, 13 and 24 constitutes indefinite subject matter as per the metes and bounds of such engender an indeterminacy in scope.

B) The recited "graft copolymer of poly(ethylene oxide) comprises poly(ethylene oxide) and at least one vinyl monomer" per claim 3 constitutes indefinite subject matter as per a) the graft copolymer as recited is repugnant to the norm and b) it is not known by any rules of Chemistry how said "copolymer" can comprise a "monomer" VS "monomer unit"(See also claims 4, 5, 7, 8, 14, 15-19, 25 and 26 in this regard).

C) The recited contents per claims 6, 10-12 and 21-23 constitute indefinite subject matter as per the entity that such is being based on is not readily ascertainable, i.e., total composition, melt blend or else.

D) The recite "polar vinyl polymer" per claim 6 is recited in duplicate.

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E) The recited “derivatives or analogs of poly(ethyl glycol) methacrylate” per claim 7 and “derivatives and analogs” per claim 26 constitutes indefinite subject matter as per the metes and bounds of such derivatives and analogs engender an indeterminacy in scope.

F) The recited “compatible blend” per claim 12 constitutes indefinite subject matter as per it not being readily ascertainable as to what component(s) is being qualified.

G) The recited “copolymer of a homopolymer of poly(ethylene oxide) and at least one polar vinyl monomer” per claim 15 engenders an ambiguity.

H) The recited “vinyl monomer selected from” per claim 16 and “a monomer selected from” per claims 17 and 26 constitute indefinite subject matter as per the use of improper Markush terminology. Use of “selected from the group consisting of” is proper and is suggested.

I) The recited “one polar, vinyl monomer” per claim 25 constitutes indefinite subject matter as per it not being readily ascertainable if applicant intends “one polar monomer” + “one vinyl monomer” or “one vinyl monomer that is polar”. It is suggested that applicant adopt the terminology “one polar vinyl monomer” consistent with at least claim 4.

Response to Amendment

3) The amendment filed on 02/14/02 is sufficient to remove the prior art rejection of claims 1 and 3-32 based on 35 USC 102(b)/103 over Wysong, Welygan

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or Larson et al. However, now art has come to the Examiner's attention and a rejection based on such is deemed proper and is as set forth infra.

Claim Rejections - 35 USC § 103

3. *The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. *The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:*

- 1. Determining the scope and contents of the prior art.*
- 2. Ascertaining the differences between the prior art and the claims at issue.*
- 3. Resolving the level of ordinary skill in the pertinent art.*
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.*

5. *Claims 1 and 3-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumi et al(U.S.4,140,668) or Miyamoto et al(U.S.5,430,090) in combination with Ray-Chaudhuri et al(U.S.3,891,584).*

Sumi et al and Miyamoto et al disclose hot melt adhesive compositions, suitable for paper making such as bookbinding, wherein said compositions are defined basically as containing a polyvinyl alcohol-governed mixture. See, e.g., the Abstract and the Claims of each of Sumi et al and

Miyamoto et al. The disclosures of each of Sumi et al and Miyamoto et al differ basically from the claimed invention as per as per the non-express guidelines to incorporate, into the hot melt adhesive compositions, a graft copolymer of poly(ethylene oxide), as claimed.

Ray-Chaudhuri et al teach hot melt adhesive compositions, useful in bookbinding, and defined basically as containing a graft copolymer of a poly(ethylene oxide)-governed melt mixture. See, e.g., the Abstract, the paragraph bridging cols. 2-3, cols. 3-6 and the Runs of Ray-Chaudhuri et al. Therefore, it would have been obvious to the skilled artisan to add the graft copolymer of poly(ethylene oxide) of Ray-Chaudhuri et al to the polyvinyl alcohol-governed melt mixture of Sumi et al or Miyamoto et al and with a reasonable expectation of obtaining the cumulative, additive effect. It is well established that no patentable invention resides in combining old ingredients of known properties. The combination of two compositions, each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition that is used for the very same purpose is prima facie obvious as authorized by In re Kerkhoven(205 USPQ 1069, CCPA 1980).

Response to Arguments

6. Applicant's arguments with respect to claims 1 and 3-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

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7. *The prior art to Harreus et al(U.S. 3,984,494) and JP 51077632(ABSTRACT) is cited as of interest and considered merely cumulative to the prior art supra.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

J. M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
May 3, 2002